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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/928,856
Filing Date: August 13, 2001
Appellant(s): VIGIL ET AL.

Wesley L. Austin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 19, 2006 appealing from the Office action mailed April 21, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,908,389	PUSKALA	6-2005
2002/0174106	MARTIN	11-2002
2002/0178353	GRAHAM	11-2002

(9) Grounds of Rejection

The following ground(s) of rejection were applied in the Final Office Action and are applicable to the appealed claims:

a). Claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No. 6,908,389) in view of Martin (US Pub No. 2002/0174106 A1).

With regard to claim 1:

Puskala discloses a hand-held wireless telecommunications device (Fig. 2, #**10**) configured to send a text message to a recipient (**20**) through use of a global computer network (**30, 43**), the wireless device (**10**) comprising:

a processor (**50**);

an input component (**60**) in electronic communication with the processor for a user to enter user input, wherein the input component may be, for example, a keypad or a keyboard for entering textual information (column 1, lines 54-56, column 3, lines 25-27, column 6, lines 18-24).

a display (**52**) in electronic communication with the processor that displays information to the User;

a communications module (**54**) in electronic communication with the processor for communicating with the global computer network;

memory **(56)** in electronic communication with the processor for storing data;

a messaging module **(62)** comprising instructions that are executable by the processor for implementing a method comprising:

connecting **(15)** the wireless device to the global computer network (Fig. 1);

displaying (column 12, lines 18-28) network data received from the global computer network on the display (e.g., Figs. 5b, 5C);

enabling the user to establish communications with a message web site (column 4, lines 27-59);

providing to the user a message user interface to select a message from a plurality of predefined ("preconfigured") messages (see Table 1), column 10, lines 5-column 10, lines 25), each of the plurality of messages being predefined to be sent to a recipient, wherein the messaging module receives the plurality of predefined messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of predefined messages (column 11, lines 27-58);

providing to the user (e.g., wireless device **10**) a recipient user interface (e.g., list menu, Fig. 7B) to select the recipient (column 4, lines 12-15); and

sending (e.g., via communication link **15**) the message to the recipient (e.g., wireless device **20**) through the global computer network (column 11, lines 27-28).

While Puskala discloses memory (**56**) in electronic communication with the processor for storing data, but Puskala does not explicitly disclose that "the data comprises at least one token". Also while Puskala discloses a messaging module (**62**) comprising instructions that are executable by the processor for implementing the "providing" method step above, but Puskala does not explicitly disclose that "at least one of the messages is a text message that includes at least one token". Puskala also fails to disclose "the messaging module allows the user to enter token text to replace the at least one token in the message" as claimed in the "message module" of claim 1. Martin, however, discloses a connector (a software component) that includes a template, which may include some specific actions/text, and placeholder tokens, for data to be added by the user. Placeholder tokens are the vehicle by which user input and "real time" data and context are transferred from a client to an agent. For one embodiment, placeholder tokens also determine when a connector is selected (Par. 65). The placeholder tokens are replaced with their associated data. Placeholder tokens may include run time data such as current date, current time, client id, user input arguments, categories, etc. This data is characterized as anything that would logically need to be chosen by a client (as opposed to

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static reference data). The client includes all potential placeholder tokens and has routines that can supply the correct replacement data (Par. 77).

Puskala and Martin are analogous art because they are from the same field of endeavor, text information processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the user defined message by selecting *4 – USER DEFINED MSG at screen 74, Fig. 5A (col. 9, lines 38-39) of Puskala with a user editable placeholder token of Martin so that the number of clicks required by the user interface is kept to a minimum (Puskala, col. 9, lines 38-38-44). Also as suggested by Martin, one only has to replace the placeholder token, instead of rewritten the whole text messages, thus, similar to Puskala and the current invention the number of clicks required by the user interface may be kept to a minimum (paragraphs 65, 66, 70, 77 and 78).

Therefore, it would have been obvious to combine Puskala with Martin to obtain the invention as specified in claim 1.

With regard to claim 2:

Puskala in view of Martin further discloses that said hand-held wireless telecommunications device is a mobile telephone (Fig. 2).

With regard to claim 3:

Puskala in view of Martin further discloses that said hand-held wireless telecommunications device is a personal digital assistant (column 4, lines 30-31).

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With regard to claim 7:

Puskala in view of Martin further discloses that said message is at least an electronic mail messages (column 1, lines 12-15).

With regard to claim 8:

Puskala in view of Martin further discloses that said network data comprises Wireless Markup Language (WML) (column 6, lines 35-36).

With regard to claim 13:

Puskala discloses a web site (Fig. 1) for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices (e.g., devices 10 and 20), the web site comprising:

a web server (Fig. 1, column 8, lines 51-63) for serving web data to a plurality of wireless devices;

a computer (server at game platform 40, Fig. 1) enabling operation of the web server, the computer being in electronic communication with a storage device (Fig. 3, column 6, lines 45-column 7, lines 6) storing instructions executable by the computer for implementing a method comprising:

allowing a wireless device to contact the web site via a global computer network (column 4, lines 12-20);

receiving from the wireless device (e.g. device 10 or 20) user identification (column 2, lines 23-46);

sending an address list identified through use of the user identification from the

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web site to the wireless device (column 9, lines 5-47);

sending a plurality of preconfigured messages identified through use of the user

identification from the web site to the wireless device, each of the plurality of messages being predefined ("preconfigured") to be sent to a recipient (Figs. 5B-5C, column 9, lines 58-column 10, lines 14);

receiving a message and the recipient from the wireless device, wherein the

message is selected from the preconfigured messages by a user through the wireless device, and wherein the recipient is selected from the address list by the user through the wireless device (column 12, lines 18-28); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

As cited above, while Puskala discloses "a computer enabling operation ..." comprising "sending a plurality of preconfigured messages ...", Puskala, however does not further describe the "sending a plurality of preconfigured messages ... wherein at least one of the preconfigured messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device". The claimed subject matter is substantially similar to claim 1, thus, Martin, as given rejection to claim 1 above, discloses the claimed subject matter that is missing from Puskala

(please see rejection of claim 1). Thus, Puskala and Martin render claim 13 obvious.

With regard to claim 14:

Puskala in view of Martin further discloses storing the preconfigured messages on the storage device (column 2, lines 23-46).

With regard to claim 15:

Puskala in view of Martin further discloses sending user interface data (e.g., menu list, Figs. 5A-5C) to a client computer to present an edit user interface on the client computer; and receiving a change from the client computer to change one of the preconfigured messages (column 7, lines 14-46, column 11, lines 27-58).

With regard to claim 18:

Puskala in view of Martin further discloses that server at platform 40 (web server) serves the web data to a plurality of mobile telephones (column 4, lines 27-59, Fig. 1, 10 and 20).

With regard to claim 19:

Puskala in view of Martin further discloses that server at platform 40 (web server) serves the web data to a plurality of personal digital assistants (column 4, lines 27-59).

With regard to claim 23:

Puskala in view of Martin further discloses that the message is an e-mail message and wherein the method further comprises e-mailing the e-mail

message to the recipient through the global computer network (column 1, lines 11-38).

With regard to claim 24:

Puskala in view of Martin further discloses that the web data comprises WML (page 13, lines 15-17).

With regard to claim 29:

Puskala discloses a method for providing predefined ("preconfigured") messages (e.g., see Figs. 5A-5C, table 1) to a hand-held wireless telecommunications device (**10**) to be sent to a recipient (**20**) through use of a global computer network (**30, 43**), the method comprising:

establishing electronic communication between the wireless device (**10**) and the global computer network (**30, 43**) (Fig. 1);

establishing electronic communication between the wireless device (**10**) and a web site storing preconfigured messages (at message database **31**), each of the messages being preconfigured to be sent to a recipient (**20**) (column 2, lines 23-46);

retrieving destination address (address list) from the web site based on user identification (column 8, lines 51-63,);

sending the address list to the wireless device (column 5, lines 1-22, column 8, lines 51-63);

providing to a user (**10**) a recipient user interface to select the recipient from the address list (column 5, lines 1-22, column 8, lines 51-63);

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retrieving the preconfigured messages from the web site based on user identification (column 5, lines 1-22, column 8, lines 51-63, column 12, lines 18-28);

sending the preconfigured messages to the wireless device (column 11, lines 59-column 12, lines 17);

providing to the user a message user interface to select a message from the preconfigured messages (Figs. 5A-5C, table 1, column 10, lines 14-29); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

While Puskala discloses “establishing electronic communication between the wireless device and a web site” as cited above, but Puskala does not further describe “wherein at least one of the messages is a text message that includes at least one token, and wherein at least one token is editable by the user using the wireless device” . furthermore while Puskala describes “providing to the user a message user interface” but Puskala does not describe far enough to teach “the message includes a token, the message user interface allows the user to input token text”. But the combined art of Puskala and Martin render claim 29 obvious (see claim 1 rejection).

With regard to claim 30:

Puskala in view of Martin further discloses providing a client user interface (e.g., menu list, FIG. 5A-5C) to a client computer via the global

computer network (30, 43) to enable the creation of the preconfigured messages that are stored (31) on the web site (column 5, lines 1-22).

With regard to claim 33:

Puskala in view of Martin further discloses that the wireless device is a mobile telephone (Fig. 2, #10).

With regard to claim 34:

Puskala in view of Martin further discloses that the wireless device is a personal digital assistant (column 4, lines 20-31).

With regard to claim 37:

Puskala in view of Martin further discloses that the recipient user interface and the message user interface comprise WML instructions (column 6, lines 35-36).

With regard to claims 16, 17, 31, and 32:

Puskala in view of Martin discloses personal information data, such as destination database 32 at the game platform 40 and another destination database 65 at the wireless device. The destination databases 65 and 32, for example stores the predefined destination address of each player (column 5, lines 58-67). The wireless device user (e.g., device 10 or 20) is allowed to edit or modify the destination address 65. The wireless device user (e.g., PDA or device 10) also receives the pre-selected or predefined destination addresses form the host (game platform (40)) via the Internet and mobile network 30 (column 2, lines 23-46).

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b). Claims 9-12, 25-28 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No, 6,908,389) in view of Graham (US Pub No. 2002/0178353 A1)

With regard to claims 9-12, 25-28 and 38-40:

Puskala in view of Martin describes customized application-specific software, which may be written in a language such as wireless markup language (WML) or Java, and alternatively, Puskala in view of Martin describes the messaging application 62 may comprise web access software (column 2, lines 23-46). But Puskala in view of Martin does not describe all HTML-compliant description languages, such as HTML, XHTML, HDML, and XML. However, Graham describes HTML, XHTML, HDML, and XML (see paragraph 32) as recited in the above claims.

Puskala, Martin and Graham are analogous art because they are from the same field of endeavor, electronic messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the HTML-compliant description languages with WAP browser software of Puskala in view of Martin's. The suggestion/motivation for doing so would have been to provide a WAP user to browse HTML-complaint content using the mobile phone effectively.

Therefore, it would have been obvious to combine Puskala in view of Marin with Graham to obtain the invention as specified in claims 9-12, 25-28 and 38-40:

Thus, the examiner successfully stated how the claim reads on the applied references, and pointed out where the claimed limitations are found in the applied references, including the arrangement of elements and functional language, by reference numerals drawing figures, and column and line number.

Closely related references

d). The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. The documents cited, Ballard (US Pat No. 6,727,916), therein teach a typical wireless device comprising a messaging module as recited in claims 1, 13, and 29. Ballard further describes providing a user a message user interface (Quick Text Choice, e.g., FIG. 6b) to select a message from a plurality of predefined messages, each of the plurality of messages being predefined to be sent to a recipient (see Fig. 6b, wherein device 100 is sending predefined text message to device 102). Mahr (6,956,831) teaches all the limitations of the independent claims (see Figs. 1-6, Abstract, and at least see column 5, lines 1-column 6, lines 16). The Applicant, however, fails to comment on these cited art made of record on form PTO-892.

(10) Response to Arguments

c). Appellants' Remarks/Arguments respects to independent claims 1, 13, and 29 have been considered but are not persuasive.

i) Before specifically discussing the Appellants' arguments, the Examiner would like to call the Board's (Board of Patent Appeals and Interferences) attention to the following matters:

The Appellant's arguments as stated in the Brief, page 9 through 17, except for part of page 9 ("Fourth Office Action"), are based on the Non-final rejection mailed on November 14, 2005 (the Appellants called it "Third Office Action") (the Appellants incorrectly put it as November 12, 2006). It looks like, the Appellant is expecting the Board to look to the Non-Final Office Action and beyond instead of looking at the Final Office Action, mailed on April 21, 2006.

The Examiner also would like to call attention to the Board that the Appellant was given opportunity to comment on the above art, not applied art (Ballard 6,727,916) and Mahr (6,956,831) but closely related to the current claimed invention (see Ground of Rejection: closely related references), but the Appellants submitted no comment at all. But the Appellants fail to traverse (comment) on such closely related art.

In general the Appellants' arguments are as follows:

ii). "*token*" is not disclosed in the applied reference as recited in the claims.

iii). The *prima facie* case of obviousness is not met.

The above argument, **ii)**, "*token*" is specifically argued as follows:

The Appellants argue Puskala does not disclose, teach, or suggest the followings: "at least one of the ... messages is a text message that includes at

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least one **token**" (claims 1, 13, and 29), "the messaging module allows the user to enter **token** text to replace the at least one **token** in the message," (claim 1), and "at least one **token** is editable by the user using the wireless device" (claims 13 and 29)

The Examiner response: in contrast to the Appellants' argument Puskala in view of Martin teaches the "placeholder" tokens that are editable, and replaceable with their associated data by the user (Martin, Pars. 65, 66, 77, and 78).

As discussed in rejection above (see Ground of Rejection), the main reference, Puskala, describes every limitation of the argued limitations except "token". Martin, however, discloses the claimed "token" (token or placeholder token) as recited in the claims.

The Appellants submit that Martin does not disclose, teach, or suggest that the "placeholder tokens" may be replaced with "token text" entered by the user or edited by the user, as recited in claims 1, 13 and 29. Rather, Martin discloses that the "placeholder tokens" are "specially flagged text that are replaced by the dispatcher in a client software prior to the dispatcher" sending a message to an agent or that the "placeholder tokens" are "filled with data" by the client or agent. See Martin, page 4, paragraphs [0066]-[0070]. However, the dispatcher, client and agent are not users, as recited in claims 1, 13 and 29. Rather, the dispatcher, client and agent are software modules.

The Examiner strongly disagrees, Martin discloses a method comprising receiving an input text expression from a user on a device, and parsing the input text expression to identify a keyword (Abstract). The placeholder token are replaced by input supplied from the user. In contrast to the Appellants'

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argument, it is the user who supplies the text data to the dispatcher not the other way around (par. 33).

As described in Pars.75-77, Martin describes that if sufficient data has been entered by the user, the Placeholder tokens are replaced with their associated data. Placeholder tokens may include run time data such as current date, current time, client id, user input arguments, categories, etc.

Furthermore, as described in Par. 65, Martin describes a connector that includes a template, which may include some specific actions/text, and placeholder token, for data to be added by the user. Placeholder tokens are the vehicle by which user input and "real time" data and context are transferred from a client to an agent. For one embodiment, placeholder tokens also determine when a connector is selected.

The Appellants submit that, though Martin discloses that "[t]he user may type, speak, write, or otherwise convey a request into the console," Martin does not disclose, teach, or suggest that "the user [may] enter token text to replace the at least one token in the message," as recited in claim 1, or that "at least one token is editable by the user," as recited in claims 13 and 29. Appellants respectfully submit that Martin's "placeholder tokens" are merely variables that may be replaced by a dispatcher, client, or agent.

In contrast to the Appellants' argument, as recited in pars.31 and 55, it is the user who manipulates, edits, and replaces text or placeholder token using the interface provided in the handheld device 110. For further information of user involvement in manipulating/replacing the displayed text, keyword, phrase or placeholder token are described in (pars. 28, 31, 33, 43, 45, 50, 55, and 119).

The Examiner would like to call the Board's attention to the alleged argument presented by the Appellant, page 10, that "the dispatcher, client and agent are not users, as recited in claims 1, 13, and 29. Rather, the dispatcher, client and agent are software modules." There is no statement/argument previously presented by the Examiner that states "the dispatcher, client and agent are users", thus, it is an irrelevant argument. The point of the matter is Martin extensively describes the user involvement in manipulating text, e.g., replacing token as recited in the claims.

Thus, as described above, Puskala in view of Martin describes that at least one of the messages is a text message that includes at least one **token** (pars. 65, 77 and 78), as recited in claims 1, 13, and 29. Puskala in view of Martin also describes allowing the user to enter token text to replace the at least one token in the message (pars. 77 and 78) as recited in claim 1. Puskala in view of Martin also describes at least one **token** is editable by the user using the wireless device (pars. 31 and 55) as recited in claims 13 and 29.

iii). The Appellants stated that a *prima facie* case of obviousness is not met, but the Examiner disagrees.

The Appellants argue that the proposed combination of Puskala and Martin is improper because Puskala teaches away from Martin. The Appellants made an error labeling Puskala as "teaching away" art. In contrast to the

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Appellants' argument, Puskala is a closely related art to both Martin and the current invention.

Just like the invention, Puskala and Martin are directed to text messaging, that is, exchange text message using hand-held device. Since editing /entering text message or data to the handheld device can be time-consuming when working on the device with a limited text-entry capability, the applied art and the current invention adapted an innovative idea. Puskala, for example, describes "It is advantageous to predefine messages when the same content is to be sent multiple times to one or many recipients so that it is unnecessary to repeatedly recreate the content of those messages." (Col. 1, lines 25-27). Similarly, Martin and the current invention describe the use of token in text messaging to accelerate the text editing/entering process or to enter the minimal input (Invention, page 10, lines 4-14) or single keyword (Martin, pars. 63 and 73).

Also, the current invention, Puskala and Martin are directed in minimizing the user entry when manipulating a message using predefined/stored (as described in Puskala) placeholder token or token (as described in Martin and the current invention). The incorporation of said token minimizes the number of clicks required by the user interface when manipulating a message (Puskala, column 9, lines 22-47).

The Examiner would like to call the Board's attention in the Brief, pages 11 through 17. The Appellants argue that the proposed combination of Puskala and Martin is improper but they are simply attacking Puskala alone. For, example, in page 11, "Puskala only discloses the use of entirely predefined messages, and not token as recited in claims 1, 13 and 29, because entering text during gameplay would interrupt the game." In regard to such argument, the Examiner clearly indicated (in the Ground of rejection) that the only claimed element Puskala is not disclosing is the claimed "token". Martin, which is directed to text messaging describes said "placeholder" token. The Appellants, however, are attempting to show non-obviousness by attacking Puskala individually where the rejection is based on a combination of Puskala and Martin.

Again, the Appellants argue "Puskala not only teaches away from the use of tokens, as recited in claims 1, 13 and 29, but the use of tokens with Puskala's predefined messages for multiplayer gaming would destroy the very purpose of the invention in Puskala, because it would interrupt gameplay. Therefore, because Puskala teaches away from these claim elements, Puskala cannot be combined with Martin to render claims 1, 13 and 29 unpatentable." The examiner strongly disagrees because similar to the "token" in the current invention (Invention, page 10, lines 4-14), Puskala's predefined messages (and possibly stored) serve to minimize the editing/entering of text messages. Furthermore, since the messages are predefined and possibly stored, the player

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will be able to send the predefined/stored message to another player in no time, without entering text from scratch (Puskala, column 7, lines 16-50).

Similarly, the use of "token" in the current invention is used as replaceable variable, text placeholder, instead of rewriting the whole text message.

Again, on page 14 through 17 of the Brief, the Appellants argue the "user-defined message" is not a "token", but is merely a message that is predefined by the user prior to gameplay. Again, the Appellants are attempting to show non-obviousness by attacking Puskala individually where the rejection is based on a combination of Puskala and Martin.

Again, the Appellants argue that the Graham's teachings are irrelevant because Puskala does not teach the user of token. Graham does not teach "token". The Appellants are attempting to show non-obviousness by attacking Puskala individually where the rejection is based on a combination of Puskala, Martin and Graham.

Thus, as described above, in the Ground of Rejection and in the response to the appellants' arguments, the examiner has indicated the teachings of the cited references in view of the claimed invention and clearly established the prima facie case of an obviousness rejection. Accordingly, the Examiner respectfully submits that the current claimed invention is not patentably distinct from the cited references.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

TH

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